

REMARKS

Claims 54-60 have been cancelled. Claims 1-44 were previously cancelled. Thus, claims 45-53 remain in the application.

Claims 54-60 were rejected in the outstanding Office Action under 35 U.S.C. §102(b) as being anticipated by DDD 148,997 as stated on pages 2 and 3 of the Office Action. This rejection has been rendered moot by the cancellation of claims 54-60.

Claims 45-53 were rejected in the Office Action under 35 U.S.C. §251 as being broadened in a reissue application filed outside the two year statutory period as stated on page 3 of the Office Action. It is alleged in the rejection that the addition of process claims 45-53 is considered as broadening of the invention because there were no process claims in the original patent. This rejection is hereby traversed and reconsideration thereof is respectfully requested in view of Applicants remarks set forth below.

The presently issue application was filed November 3, 2000, more than two years after the issue date of U.S. Patent No. 5,230,747, issued July 27, 1993, for which Applicants seek a reissue patent. However, it is respectfully submitted that claims 45-53 in the application are properly presented under 35 U.S.C. §251 as they are not broadened relative to the claims in U.S. Patent No. 5,230,747, but include all the limitations of independent claim 1 of U.S. Patent No. 5,230,747.

The single independent claim, claim 1, of U.S. Patent No. 5,230,747 is directed to a product, e.g. a wafer for forming an integrated circuit thereon, the wafer comprising:

- a main surface on which an integrated circuit is to be formed;

- a substantial circular contour portion surrounding said main surface;
- a curved notch formed in said circular contour portion; and
- connecting portions defined between said circular contour portion and said curved notch, wherein the connecting portions are chamfered in a plane parallel to said main surface.

Claims 45-53 in the present application for reissue are each directed to a process for producing a semiconductor device which includes providing a wafer which includes each of the aforementioned limitations of claim 1 of U.S. Patent No. 5,230,747. Thus, claims 45-53 are not broader than claim 1 of U.S. Patent No. 5,230,747.

The Manual of Patent Examining Procedure (M.P.E.P.) Section 821.04 Rejoinder, makes it clear that where product and process claims drawn to independent and distinct inventions are presented in the same application, applicant may be called upon under 35 U.S.C. §121 to elect claims to either the product or process. The claims to the nonelected invention will be withdrawn from further consideration under 37 C.F.R. §1.142. However, if applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all of the limitations of the allowable product claim will be rejoined.

The present reissue application claims 45-53 are process claims which include all of the limitations of the allowable product claim, claim 1 of U.S. Patent No. 5,230,747, and could have properly been presented and allowed in the original U.S. Patent No. 5,230,747. It was an error that such claims were

not presented during the prosecution of U.S. Patent No. 5,230,747, which error is correctable under 35 U.S.C. §251 by the present reissue application.

The decisions in *In re Weiler, et al.*, 790 F.2d 1576, U.S. App. LEXIS 20071, 229 USPQ (BNA) 673 (CAFC 1986) and *Ex parte Wikdahl*, 10 USPQ 2d 1546 (Bd. Pat. App. & Inter. 1989) were cited in support of the rejection of claims 45-53 under 35 U.S.C. §251 in the Office Action. These decisions are inapplicable to this case. *In re Weiler, et al.* involved rejected reissue claims 13 and 19 which were directed to subject matter not claimed at all in the original application. The court stated that *Weiler et al.* had no right to insert and present reissue claims 13 and 19 in the original application after the Examiner's requirement for restriction. In contrast, in the present case Applicants reissue application process claims 45-53 include all of the limitations of the allowed product claim, claim 1, of U.S. Patent No. 5,230,747, such that claims 45-53 could have properly been added to the original application with the elected group in accordance with permissible rejoinder under M.P.E.P. 821.04. That the claims were not presented in the original application is an error correctable under 35 U.S.C. §251.

The Court of Appeals for the Federal Circuit, in *In re Doyle*, 293 F.3d 1355, 2002 U.S. App. LEXIS 11635 63 USPQ 2d (BNA) 1161 (Fed. Cir. 2002) distinguished *In re Weiler, et al.* as applying only to an attempt to assert new claims in reissue that read on a separate invention and not on the subject matter of the issued claims. The court noted in *In re Doyle* that Dr. Doyle's claims were not to an invention distinct from that of the issued claims, but rather claims which read on, and could have been asserted with the elected group. This rule by the court in *In re Doyle* applies in the present case where

Applicants reissue application claims 45-53 could have been asserted with the elected group in the original application since they include all of the limitations of the allowable independent product claim of the elected group and rejoinder would have been permitted. The decision in Ex parte Wikdahl pertains to reexamination under 35 U.S.C. §305, not reissue under 35 U.S.C. §251, and is not controlling in the present case.

It is further stated in the rejection of claims 45-53 that the process claims 45-53 are directed to the same subject matter as the non-elected claims of the original application and that Applicant has failed to file a divisional application for the non-elected claims. This assertion in the rejection is incorrect. Applicants, in fact, filed a divisional application to the nonelected invention in the original application, which issued as U.S. Patent No. 5,279,992, as noted in the remarks in Applicants Amendment filed April 30, 2002, see page 12. Applicants did not forego a divisional application and are within their rights under 35 U.S.C. §251 to file this reissue application with claims 45-53 directed to processes which include all of the limitations of an allowed product claim in original U.S. Patent No. 5,230,747 for the reasons stated above.

It is further stated in the rejection of claims 45-53 that a claim is broader in scope than the original claims if it contains within its scope any conceivable product or process which would (not, sic) have infringed the original patent. A claim is broadened if it is broader in any one respect even though it may be narrower in other respects. Applicants note that the word "not" is erroneously omitted in the statement in the Office Action. In any event, the statement in the Office Action is not applicable in the present case

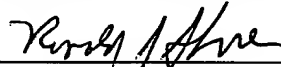
since claims 45-53 contain all of the limitations of claim 1 of U.S. Patent No. 5,230,747 such that they are not broader in any respect. A process which infringes any of claims 45-53 would also infringe claim 1 of the original patent because under 35 U.S.C. §271(a) it is an infringement to make a patented product without authority.

In view of the above amendments and remarks, it is respectfully submitted that claims 45-53 are now in condition for allowance. Accordingly, reconsideration and allowance of these claims as respectfully requested.

A Petition for Extension of Time to permit the timely filing of this Amendment within the third month extension of time for responding to the Office Action of September 9, 2004 is filed herewith.

Please charge any shortage in the fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 01-2135 (Case No. 501.20289RC6) and please credit any excess fees to such deposit account.

Respectfully submitted,



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Attachments